

REMARKS

Examiner Interviews

Applicant's Attorney interviewed the Examiner on May 6, 2011. There does not appear to be a separate interview summary forthcoming from the Examiner for this interview, but a summary was provided by the Examiner in the body of the present Advisory Action.

Attorney for Applicant's recollection of this interview differs from the Examiner's in some respects. Yes, the Attorney did ask if the Examiner would be writing a second Advisory Action and the Examiner said yes – the present action is it.

The Attorney also asked about a possible issue the Examiner may have had with one or more of the new claims presented (claims 27-35) given a statement in the previous Advisory Action on a similar claim structure. It was pointed out by the Attorney that claim 30 met the "infringement test" given in MPEP 608.01(n) for determining if a claim was a proper dependent claim, so claim 30 was a proper dependent claim as presented; the Examiner agreed to look this up in the MPEP and report back on this issue in the forthcoming Advisory Action. In addition, the Examiner took the position that claim 34 was an improper multiple dependent claim; the Attorney stated that it was not intended to be multiple dependent and agreed in any case that the claim should be rewritten to avoid controversy.

The Attorney for Applicant does not recall the Examiner stating that the new claims would not be entered.

Sometime the following week, the Attorney for Applicant called the Examiner again and asked about the Advisory Action since it had not arrived by mail and had not yet shown up in PAIRS either as expected. There appears to have been a slight delay in the mail room. While on the phone, the Attorney remembers the Examiner saying that the new claims would be entered, but some might be rejected.

Claim Amendments

Claims 11 and 12 are cancelled herein (since apparently their cancellation in the previous response was Not Entered) and are rewritten in independent form as New claims 36 and 37. New claims 27-35 from the previous response were Not Entered by the Examiner. Claims 38-44 are further New claims presented here and are similar to claims 29-35 that were Not Entered. All other still pending claims before New claims 36-44 are cancelled.

Claim 38 is a narrower version of claim 37. Claim 39 is based on a combination of claims 17 and 37 (37 being of same scope as claim 12), and claim 40 is a narrower version of claim 39. Claim 41 is based on a combination of claims 10 and 20, as suggested by the Examiner, and claim 42 is a narrower version of claim 41. Claim 43 is based on a combination of claims 20 and 37 (37 being of same scope as claim 12), and claim 44 is a narrower version of claim 43.

Allowable Subject Matter/Claims

Applicant again acknowledges the Examiner's conclusions concerning allowability of the subject matter of claims 11 and 12 and the combination of claims 10 and 20 from previous actions/communications/interviews which Applicant believes the Examiner still holds -- the inclusion of claim 12 in the list of rejected claims on the Advisory Action sheet is believed to be a typographical error by the Examiner. In addition, Applicant acknowledges the Examiner's statement concerning allowability of claims 27-29, 32-33 and 35, if non-allowable claims are cancelled.

All the remaining pending claims are New claims (claims 36-44) which derive from the allowable subject matter/claims cited here and are properly written, so are allowable and do not create any issues for the Examiner and should be entered and declared allowed by the Examiner.

Amendments Not Entered

Applicant is puzzled why, of the New claims (27-35) presented in the previous response, none were entered, especially since the Examiner did not find problems with several of

them (27-29, 32-33 and 35), and these along with the cancellation of claims 11 and 12 would put the application in better form for appeal; the cancellation of claims 11 and 12 were not entered either, probably since the New claims 27 and 28 (in independent form) meant to replace them were Not Entered. The infringement test (see above) would likely allow the others (claims 30-31 and 34) to pass muster as well. Note that claim 34 did not refer to two sets of claims as the Examiner alleges, but to two claims; in any case, Applicant did not use this claim form again in the new claims presented here to avoid controversy. In the interests of speeding the conclusion of prosecution in this case, Applicant has more or less used the Examiner's models for "correcting" claims 30 and 34 to write New claims 39 and 43, even though this might not really be necessary as discussed above.

Response to Arguments

Applicant is surprised to see that the Examiner has so much to disagree with in the arguments presented by Applicant in the previous response in this case. In the interests of saving time and expense, Applicant has made a business decision to cancel all pending claims before claim 36 which should moot all rejections and objections still remaining in the case. The claims now in the case (36-44) should all be allowable as they stand presently as explained above, and the case should be able to proceed to issuance as now presented.

As they are now moot, Applicant need not (and in most cases does not) respond to the Examiner's arguments under the heading, Request for Reconsideration, in the present action. Lack of response here should not be interpreted as acquiescence by Applicant. In a few instances, Applicant has chosen to respond where Applicant felt very strongly that the Examiner was incorrect. Where the Examiner has agreed with Applicant's arguments from the previous response, Applicant hereby acknowledges this agreement; failure by Applicant to comment on specific statements made by the Examiner related to these instances should not necessarily be interpreted as acquiescence by Applicant as to such statements, unless Applicant has made the same or equivalent statements.

On pages 4-5 of the present action, the Examiner (finally) shows what Farley actually teaches – a copy of the Farley reference was mailed to Applicant on 05/06/2011 as well. This should have been done before final rejection in this case as all the rejections depended on what Farley taught as Applicant continued to bring up. Finality was improper until Farley was made of record in the case.

On pages 5-8, the Examiner makes arguments which have elements of hindsight which is impermissible - the Examiner may only look in the prior art he cites for the basis of his argument and not in Applicant's specification – and/or uses prior art references not part of his relevant rejection. In any case, the birch densities the Examiner notes are all higher than aspen and other birch properties are just not that similar to those of aspen and this was the point - the issue is aspen versus birch which is the jump the Examiner makes in the relevant rejections (that are under 103 and not say 112).

On page 10, the Examiner is making an argument that DUNLAP's one data point allows a generalization to all others in the genus. Also, the DTO and CTO in DUNLAP seem to be unrelated, so how can this be a proper comparison even for the one data point?

On page 11, the Examiner argues that present non-availability of the specific DTO in DUNLAP is motivation to try other DTO's. Wouldn't this non-availability more likely suggest that this method of DUNLAP's is not so hot rather than that it should be expanded upon using other DTO's?

Conclusion

In view of the remarks and amendments above, Applicant believes that the claims as they now stand are in a condition for allowance. Prompt allowance of all pending claims is respectfully requested.

In the event that the Examiner is not willing to allow the claims as they now stand, then Applicant requests that the Examiner contact Applicant's Attorney as soon as possible.

If it would be helpful in resolving any issues in this Application, the Examiner is invited to contact Applicant's Attorney, Charles R. Richard, at 202-246-3320.

Date: 5/19/14

Respectfully Submitted,

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